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7590 12/29/2004				
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			EXAMINER SNAY, JEFFREY R	
			ART UNIT 1743	PAPER NUMBER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 08/120,303
Filing Date: September 13, 1993
Appellant(s): JACOBS ET AL.

MAILED

DEC 29 2004

GROUP 1700

Andrew C. Farmer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 09-13-2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 11 and 17-19 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. Specifically, appellant's brief provides a statement that claim 17 stands alone, but fails to provide any reasons in support thereof. Furthermore, the rejection of claims 11 and 17-19 is traversed in the brief as a

single issue, without separate arguments in support of patentability of claim 17. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) *Grounds of Rejection*

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11 and 17-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This grounds of rejection repeats and maintains the rejection made by the Board of Patent Appeals under 37 C.F.R. § 1.196(b), entered in the decision mailed 04-28-2000.

Claim 11 recites a "means for connecting said opening of said vessel to said lumen said vessel being closed to the ambient atmosphere except through such opening". Claim 17, as now amended, recites a "means for connecting said opening of said cartridge to said lumen said cartridge being closed to the ambient atmosphere except through such opening". As articulated by the Board of Appeals in the decision

mailed 04/28/00, the present specification provides specific examples for a "means for connecting said vessel to the end of said lumen" but provides no corresponding structure for a "means for connecting said opening of said vessel to said lumen". See page 8 of the noted Board decision. Analogously, the specification provides no corresponding structure for the newly claimed "means for connecting said opening of said cartridge to said lumen said cartridge being closed to the ambient atmosphere except through such opening" as recited in claim 17. In view of the lack of a disclosed corresponding structure for connecting the opening of the vessel (claim 11), nor of the cartridge (claim 17), neither an actual means nor means that are equivalent to the actual means can be determined. Therefore, claims 11 and 17-19 are of indeterminate scope and rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

Claim 17 is further indefinite under 35 U.S.C. 112, second paragraph, for the following reasons. The claim recites as an element "a vessel including a cartridge". Thus the cartridge is an element of the vessel. This is not commensurate with the specification which teaches, with respect to Figure 2A, that the vessel is attached to a cartridge, thus forming separate elements connected together. See for example page 12 of the specification teaching that "Figure 2A illustrates a variation in the design of the device of Fig. 2 which utilizes the same basic vessel and means for attachment to a tubular device. In the device shown in Fig. 2A, end 45 of the vessel opposite the open end is provided with aperture 46 for attaching a disposable cartridge 47 containing a supply of antimicrobial on a substrate ... " Therefore, the specification fails to provide an

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adequate description by which one of ordinary skill in the art could clearly discern applicant's newly amended claim language of "a vessel including a cartridge". Furthermore, in lines 4-5 of claim 17, the meaning of "having an opening therein" cannot be determined as to whether the opening is present in the vessel or the cartridge. Furthermore, the recited language that the means for connecting includes an opening for releasably attaching the cartridge "to form said vessel" is generally vague and indefinite for the reasons stated above. Specifically, the specification clearly teaches the "vessel" and the "cartridge" as being separate and attachable elements, rather than a single "vessel".

(11) *Response to Argument*

Appellant's arguments filed 09-13-2004 have been fully considered but they are not persuasive. Applicant asserts only that the specification provides various structural embodiments suitable for accomplishing the recited functions, satisfying the requirements of 35 U.S.C. 112, sixth paragraph. However, as articulated by the Board in the earlier decision, the corresponding structure identified by the specification was associated with the "means for connecting said vessel to the end of said lumen" in claim 20. The alternative "means for connecting said opening of said vessel to said lumen" (claim 11), and "means for connecting said opening of said cartridge to said lumen" (claim 17), viewed in light of the doctrine of claim differentiation, must require some alternate corresponding structure. Such alternate corresponding structure, linked or

associated with the means recited in claims 11 and 17-19, is not identified by the specification.

Appellant's brief fails to address the Board's earlier analysis of these claims under the doctrine of claim differentiation.

Appellant's further arguments with respect to claim 17 are also not persuasive. Appellant argues that one of ordinary skill would have readily understood that the recited vessel could include the cartridge as an element thereof. However, this interpretation is not supported, and in fact opposite, to the clear language of the specification, as detailed in the grounds of rejection. Furthermore, such an interpretation is inconsistent with the latter limitation of claim 17, requiring that the "means for connecting includes an opening for releasably attaching said cartridge . . . to form said vessel." If the cartridge constitutes an element of the recited vessel, it cannot be discerned from the language of the claim, nor from the specification, what the cartridge is releasably attached to.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



Jeffrey R. Snay

Primary Examiner

Art Unit 1743

jrs

December 27, 2004

Conferees

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